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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,881	06/24/2003	Christopher Oriakhi	200210067-1	5166
22879	7590	10/28/2004	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			SASTRI, SATYA B	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 10/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,881

Applicant(s)

ORIAKHI, CHRISTOPHER

Examiner

Satya B Sastri

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 13-44 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53-66 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-12, 45, 46 and 48-52 is/are rejected.
- 7) ☒ Claim(s) 5-7 and 47 is/are objected to.
- 8) ☒ Claim(s) 1-66 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 1713

### DETAILED ACTION

1. Applicant's amendment filed September 20, 2004, has been fully considered with the following results. Election of Group I invention with *claims 1-12* and addition of new *claims 45-66* added to Group I invention are acknowledged. *Claims 13-44* are withdrawn from further consideration. In view of the amendment, objection to the specification is withdrawn. Furthermore, in view of the amendment, rejection of *claims 1, 2, 3, 5 and 11* under 35 U.S.C. 102(b) as anticipated by Strauss et al. (US 5,340,868) is withdrawn, rejection of *claim 8* under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Strauss et al. (US 5,340,868) is withdrawn and rejection of *claims 9, 10 and 12* under 35 U.S.C. 103(a) as being unpatentable over Strauss et al. (US 5,340,868) in view of Chen et al. (US 2002/0188055 A1) is withdrawn and rejection of *claims 1 and 11* under 35 U.S.C. 102(b) as anticipated by Epstein (US 4,183,759) is also withdrawn. Additionally, allowability of *claim 4* indicated in earlier office action is withdrawn and new grounds of rejection are introduced in this office action.

### *Specification*

2. The difference in scope of amended *claim 5* and newly added *claim 47* is unclear.
3. Applicant's attention is drawn to paragraph 9 of the earlier office action requesting the correct use of trademarks. The use of the trademark Liponics EG-1, Surfynol <sup>TM</sup> and Tergitol <sup>TM</sup>

Art Unit: 1713

has been noted in the table on page of the amendment. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 102 and 103***

4. ***Claims 1-4, 8-11, 45, 46, 48-51*** are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (US 6,274,661 B1).

The prior art to Chen et al. discloses fiber glass **binders** based on **polycarboxy polymer**. The polycarboxy polymers may further include, as catalyst, an **alkali metal salt of a phosphorous-containing organic acid**, particularly **alkali metal salts of phosphoric acid, polyphosphoric acid and hypophosphorous acid**. The binder compositions comprise **alcohols** such as glycerol, ethylene glycol, propane diol etc. (column 4, lines 9-47). Furthermore, the polycarboxy polymer, monomeric trihydric alcohol, phosphate-containing catalyst may be mixed with water in any conventional mixing device with agitation. The ratio of the polycarboxy polymer to monomeric trihydric alcohol may be determined by comparing ratio of the reactive functional groups. **Water** may be present up to about **95% by weight** of the binder (column 5, lines 1-24). The binders may further include additives such as **dyes**, fillers and other conventional adjuvants and has a **pH in the range of 2.5-5** (column 5, lines 25-33). Thus, currently amended ***claims 1-4, 8-11, 45, 46, 48-51*** read on the prior art to Chen et al.

Art Unit: 1713

5. *Claims 12, 52* are rejected under 35 U.S.C. 103(a) as being obvious over (US 6,274,661 B1) in view of Dobrowolski (US 2004/0152824 A1).

The prior art to Chen et al. is elaborated above in paragraph 4 above and is incorporated herein by reference.

The difference between the instant invention and prior art is the inclusion of surfactants in the binder compositions of present invention.

The prior art to Dobrowolski pertains to surfactant-containing insulation binder based on polycarboxy acid. The disclosure further teaches that if appropriate surfactant is added to the polycarboxy polymer binder composition, the surface tension of the polycarboxy polymer binder composition is reduced, enabling a great improvement in binder wetting and in the distribution of the binder into the fiberglass matrix (page 1, paragraph 0006). In light of such benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a surfactant in the binder compositions of Chen et al. and thereby obtain the present invention.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. *Claims 1-4, 8-12, 45, 46, 48-52* are rejected under 35 U.S.C. 102(a) as being anticipated by Taylor et al. (US 6,734,237 B1).

Art Unit: 1713

Taylor et al. disclose fiberglass binder composition comprising a **polycarboxy polymer**, **polyol** and an imidazoline. The binder also comprises a catalyst which is an **alkali metal salt of a phosphorous-containing organic acid** (abstract, column 5, lines 19-41). Polycarboxy polymers comprise **homopolymers and copolymers of polyacrylic acid** (column 4, lines 9-18). The ratio of the number of equivalents of carboxyl groups of the polyacid to the number of hydroxy in the polyol may range from **1/0.1 to 1/3** (column 4, lines 40-57). The **pH** of the binder resin may be at most **4.5**. The **aqueous binder resin** may further include **emulsifiers, colorants** etc (column 5, lines 42-57). Thus, *claims 1-4, 8-12, 45, 46, 48-52* read on the prior art binder resin compositions.

*Allowable Subject Matter*

8. *Claims 53-66* are allowable.
9. *Claims 5-7, 47* are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Instant claims are directed to a binder composition comprising an organic acid comprising a phosphate ion and comprising citric acid or phytic acid or a colorant comprising a pigment suspended as particles and a dye dissolved in said composition, respectively. Such modifications are not disclosed in the prior art.

*Response to arguments/Remarks*

10. Applicant's argue that the prior office action dated June 24, 2004 does not indicate how or where applied prior art to Strauss teaches the claimed binder composition comprising an acid that includes a phosphate ion. Applicants' attention is drawn to original *claim 1* to a binder composition, which comprises an organic acid and/or an inorganic acid including a phosphate ion; a polyacid, and a primarily aqueous solvent. The examiner interprets such a claim language, in the absence of a comma after inorganic acid, to imply that the composition comprises either an organic acid (with or without a phosphate ion) or an inorganic acid including a phosphate ion or both acids.

*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 212 1112.

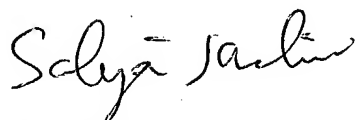
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 212 1114.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Art Unit: 1713

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

October 21, 2004



DAVID W. WU  
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